

REMARKS

Claims 1 to 24 were pending in the application at the time of examination. Claims 1 to 24 stand rejected as obvious.

Applicants have amended Claims 1, 10, 12, 15, and 22 to clarify that reference data is data that characterizes a data source as described and illustrated in the specification. This was done to remove any confusion as to inherent characteristics of the elements recited in the claims that should be considered in an obviousness rejection. Moreover, when the claims were interpreted in view of the specification, these amendments are clearly inherent in the original claims.

Claims 1 to 4, 6 to 18, and 20 to 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,529,911 B1, hereinafter Mielenhausen, in view of U.S. Patent No. 5,867,678, hereinafter Amro.

Mielenhausen describes "A data processing system for and method for organizing analyzing, recording, storing, and reporting research results." (Mielenhausen, ABSTRACT.). Mielenhausen describes the way the system functions as:

. . . A data processing method for organizing, analyzing, recording, storing, and reporting research results, comprising the steps of:

- inputting user identification data,
- inputting information related to a plurality of research projects,
- inputting information related to a plurality of propositions
- associating each of the propositions with at least one of the research projects,
- inputting information on a plurality of authorities, associating each of the authorities with at least one of said plurality of research projects,

outputting a propositions report displaying the information associated with selected propositions, and
outputting an authorities report displaying the information associated with selected authorities.

Mielenhausen, Col. 2, lines 18 to 35. Thus, the system utilizes inputting, associating and outputting steps. The system is not described as including, for example, a determining operation.

Despite this clear sequence of steps defined by Mielenhausen, as explained more completely below, the rejection of Claim 1 takes pieces of Mielenhausen and rearranges the pieces, which goes against the explicit methodology quoted above, and creates results that are unrelated to the explicit claim limitations of Claim 1.

The Examiner first stated in part (all emphasis in original):

a). **'entering user inputted text data for said computer-readable document in a data file'** as through the Legal Research Organizer(LRO)'s Transfer Project Data Window, all data tied to the project description highlight[Sic] in the Projects Window can be transferred to or from another LRO program via floppy disk or modem. Thus, the user's project data can be placed in a data file to be loaded on to a floppy disk to transfer to another project (col. 5, lines 55-59 and lines 48 to 54.)

Mielenhausen taught at Col. 5, lines 48 to 59 (Emphasis added):

(a) Through LRO's **View/Copy Project Data Window**, the user can view **all data tied to the project description highlighted in the Projects Window**. LRO displays the data in the Propositions Report format (explained in Step 800, below), outlining all data on all propositions tied to the highlighted project. All or part of the report can be copied, pasted, printed, or copied to floppy disk.

(b) Through LRO's Transfer Project Data Window, all data tied to the project description highlighted in the Projects Window can be transferred to or from another LRO program on an off-network computer (e.g., a laptop), via floppy disk or modem. The transferred data is not in the Propositions Report format described above. Instead, the data is in a format that enables a receiving LRO program to automatically sort the data to the pertinent or new windows in an existing or new project.

The fact that data "tied to the project description highlighted in the Projects Window" can be transferred to a file teaches or suggests nothing about the first element of Claim 1. The Examiner has cited no teaching that the transferred data is user inputted, and has cited no teaching that the user inputted data is text data.

Thus, the rejection shows that the Examiner has rejected the gist of this element and not the specific claim language. The MPEP directs:

DISTILLING THE INVENTION DOWN TO A "GIST" OR "THRUST" OF AN INVENTION DISREGARDS "AS A WHOLE" REQUIREMENT

Distilling an invention down to the "gist" or "thrust" of an invention disregards the requirement of analyzing the subject matter "as a whole."

MPEP § 2141.02, Eighth Edition, Rev. 2, p. 2100-125, (May 2004)

Nevertheless, according to the rejection, the data file is one that is obtained by transferring data "tied to the project description highlighted in the Projects Window."

Next, the Examiner stated in part:

b). 'determining whether a user inputted a request to input reference data' as when the user navigate [Sic] to LRO's Transfer Project Data Window, it is apparent that the user attempts to input the project data into a file and transfer it to another LRO program (col. 5, lines 27-28; col. 6, line 25 and 40);

The rejection again demonstrates that the claim language is being considered in a vacuum and not as required by the MPEP. The comments have nothing to do with the quoted claim language. A user attempting "to input project data into a file and transfer it to another LRO program," is unrelated to "determining whether a user inputted a request to input reference data."

Moreover, Mielenhausen taught at Col. 5, lines 27 to 28:

Step 300: Input Information Related to Each Legal Research Project;

at Col. 6, line 25:

Step 400: Input Information Related to Each Proposition;

and at Col. 6, line 40:

outlining all data on the highlighted proposition.

None of these citations describes or suggests a determining operation and none describes or suggests "a user inputted request to input reference data."

The Examiner is reminded that the MPEP requires:

Office personnel must first determine the scope of a claim by thoroughly analyzing the language of the claim before determining if the claim complies with each statutory requirement for patentability. (Emphasis in original.)

MPEP § 2106 C., 8th Ed., Rev. 2, p 2100-7, (May 2004).

The MPEP further requires:

Office personnel are to correlate each claim limitation to all portions of the disclosure that describe the claim limitation. This is to be done in all cases, i.e., whether or not the claimed invention is defined

using means or step plus function language. The correlation step will ensure that Office personnel correctly interpret each claim limitation.

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. (Emphasis added.)

MPEP § 2106 C., 8th Ed., Rev. 2, p 2100-8, (May 2004). The above rejection demonstrates that these requirements of the MPEP have not been followed with respect to claim interpretation and that explicit claim limitations have not been considered.

Moreover, the Examiner cites to two different operations as shown in Fig. 4A of Mielenhausen as teaching this limitation. This ignores that the reference teaches that the operations are different and ignores that the operations are described as "Input" operations and not determining operations as recited in this claim element. If the Examiner continues the rejection, the Examiner is respectfully requested to explain how the rejection complies with the requirements of the MPEP with respect to claim interpretation, considering the claims as a whole, and the justification in the prior art for modifying an input operation, i.e., the cited steps 300 and 400, to be a determining operation. Without such information, the MPEP requirements are not met.

In the rejection, of the next element in Claim 1, the Examiner stated:

c). 'entering user inputted reference data into the reference database following said determining finding said user inputted said request to input reference data' as the user can add one or more citations to the Research Database search Results window and LRO automatically saves data when user closes a window(col. 8, lines 1-10; col. 5, lines 29-36; col. 17, lines 40-44);.

Mielenhausen taught at Col. 8, lines 1 to 10:

(b) Through LRO's Paste/View Research Database Cite List Window, the user can paste a list of citations, downloaded from the CD-ROM or on-line research database, for the word search highlighted in the Word Searches Window. The user can then add one or more of those citations to the Research Database Search Results Window, along with data showing the status of the user's review of each citation. The Cite List Window indicates the date each list relating to the database was pasted.;

and at Col. 5, lines 29 to 36:

Through LRO's Projects Window (FIG. 6), the user can view, add and edit descriptions of the research projects tied to the user's or network's LRO license number. Each description includes the project number (e.g., "98-100532"), the project name, the client name and number, the matter name and number, the case name and court file number, the date the project description was last edited, and each user who has entered or edited project data. LRO automatically

These citations do not indicate how or in what the data is stored. The fact that the data is stored when the window is closed fails to teach or suggest that the data is stored in a "reference database." Moreover, these citations are not related to the outcome of the "determining operation" as recited in the Claim. Also, a citation is not reference data.

According to the rejection, the determining operation was associated with the totality of steps 300 and 400 of Mielenhausen, but the citation at column 8 is to a step 430 that is within step 400. Thus, according to the Examiner's interpretation of the reference, step 400 is performed and then step 430 follows. This rearrangement of the teaching of the reference goes against the explicit sequence of operations defined by the reference and is further evidence as originally stated that neither the reference nor Applicants' claim is being considered as a whole. Again, the MPEP directs:

**FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT
SUFFICIENT TO ESTABLISH PRIMA FACIE OBVIOUSNESS**

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

MPEP § 2143.01, Eighth Edition, Rev. 2, p. 2100-131, (May 2004). The primary reference not only does not teach the desirability of the modification, but also the primary reference teaches away from the modification. Thus, according to the MPEP, a prima facie obviousness basis for the rejection has not been established.

Next, the Examiner cited to the same text, Col. 8, lines 1 to 10, in Mielenhausen as teaching "wherein said other data includes at least one citation to said user inputted reference data," as was cited to suggest the previous claim limitation. This is but further evidence that the explicit claim limitations are not being considered. A citation of the user inputted reference data is different from the inputted reference data.

Above, the Examiner indicated that the data file was "loaded on a floppy disk to transfer to another project." The next Examiner cited to Amro and then stated:

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Amro's** teaching would have allowed **Mielenhausen's** to ensure that all reference related data is available for access by binding separate documents together can create a well organized, coherent collection of information as suggested by Kanerva at col. 1 lines 15-18.

This motivation is not-based upon considering Mielenhausen as a whole. For example, Mielenhausen's system was for "organizing, analyzing, recording, storing, and reporting research results," i.e., "binding separate documents together" to "create a well organized coherent collection of

information," which in Mielenhausen's example was legal research results. The very motivation relied upon by the Examiner was the purpose of Mielenhausen's system and so cannot provide a motivation to modify Mielenhausen. Moreover, Kanerva at the cited location is describing "separate paper documents." Binding of separate paper documents is unrelated to anything in either Mielenhausen or Applicant's invention as recited in Claim 1 and so provides no basis for the Examiner's conclusory comments.

Moreover, the motivation fails to explain how Amro would be incorporated into Mielenhausen, and fails to explain how Mielenhausen would work. Mielenhausen explicitly pointed out in the section cited by the Examiner:

The transferred data is not in the Propositions Report format described above. Instead, the data is in a format that enables a receiving LRO program to automatically sort the data to the pertinent or new windows in an existing or new project.

The transfer of data relied upon by the Examiner is described in a specific format. To make the modification, the Examiner must demonstrate that Mielenhausen would still work for its intended purpose. Conclusory comments that contradict the teachings of the primary reference and are justified by considerations of paper documents fails to met the requirements set forth in the MPEP for combination of references.

In view of the rejection's failure to comply with multiple requirements sent forth in the MPEP, the rejection fails to establish a prima facie obviousness rejection. Any one of the distinctions cited above is sufficient to overcome the obviousness rejection, Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 1.

Claims 2 to 4 and 6 to 9 depend from Claim 1 and distinguish over the combination of references for at least the same reasons as Claim 1. Applicants request reconsideration

and withdrawal of the obviousness rejection of each of Claims 2 to 4 and 6 to 9.

Claim 5 stands rejected as obvious in view of Mielenhausen and Amro taken together with U.S. Patent No. 6,289,342 B1, hereinafter Lawrence. However, assuming that the combination of the three references is correct and that the interpretation of the three references is correct (Applicants note that by making these assumptions Applicants do not concede that either of these facts is correct), the additional information from the third reference does not correct the deficiencies of the two primary references as noted above with respect to Claim 1 and incorporated herein by reference. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 5.

The obviousness rejection of Claim 10 relied upon the same information as discussed above for Claim 1. Claim 10 also includes language equivalent to that discussed above for Claim 1. Therefore, the above discussion of Claim 1 is applicable to Claim 10 and is incorporated herein by reference.

Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 10.

Claim 11 depends from Claim 10 and so distinguishes over the combination of references for at least the same reasons as Claim 10. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 11.

The obviousness rejection of Claim 12 relied upon the same information as discussed above for Claim 1. Claim 12 also includes language equivalent to that discussed above for Claim 1. Therefore, the above discussion of Claim 1 is applicable to Claim 12 and is incorporated herein by reference.

Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 12.

Claims 13 and 14 depend from Claim 12 and so distinguish over the combination of references for at least the same

reasons as Claim 12. Applicants request reconsideration and withdrawal of the obviousness rejections of Claims 13 and 14.

The obviousness rejection of Claim 15 relied upon the same information as discussed above for Claim 1. Claim 15 also includes language equivalent to that discussed above for Claim 1. Therefore, the above discussion of Claim 1 is applicable to Claim 15 and is incorporated herein by reference.

Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 15.

Claims 16 to 18, 20 and 21 depend from Claim 15 and so distinguish over the combination of references for at least the same reasons as Claim 15. Applicants request reconsideration and withdrawal of the obviousness rejections of each of Claims 16 to 18, 20 and 21.

Claim 19 stands rejected as obvious in view of Mielenhausen and Amro taken together with U.S. Patent No. 6,289,342 B1, hereinafter Lawrence. However, assuming that the combination of the three references is correct and that the interpretation of the three references is correct (Applicants note that by making these assumptions Applicants do not concede that either of these facts is correct), the additional information from the third reference does not correct the deficiencies of the two primary references as noted above with respect to Claim 15 and incorporated herein by reference. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 19.


The obviousness rejection of Claim 22 relied upon the same information as discussed above for Claim 1. Claim 22 also includes language equivalent to that discussed above for Claim 1. Therefore, the above discussion of Claim 1 is applicable to Claim 22 and is incorporated herein by reference. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 22.

Claims 23 and 24 depend from Claim 22 and so distinguish over the combination of references for at least the same reasons as Claim 22. Applicants request reconsideration and withdrawal of the obviousness rejection of each of Claims 23 and 24.

Claims 1 to 24 remain in the application. Claims 1, 10, 12, 15 and 22 have been amended. For the foregoing reasons, Applicant(s) respectfully request allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant(s).

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on October 18, 2004.



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October 18, 2004
Date of Signature

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